

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

VB

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/127, 364 07/31/98 YEDNOCK

T 193-US-CIP2

021835 HM12/0418
ELAN PHARMACEUTICALS, INC.
LEGAL DEPARTMENT PATENTS
800 GATEWAY BOULEVARD
SOUTH SAN FRANCISCO CA 94080

EXAMINER

LUKTON, D

ART UNIT	PAPER NUMBER
----------	--------------

1653

7

DATE MAILED:

04/18/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No. 09/127,364	Applicant(s) Yedn ck
Examiner David Lukt n	Group Art Unit 1653



Responsive to communication(s) filed on Feb 1, 1999

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire _____ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

Claim(s) 1-23 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) _____ is/are rejected.

Claim(s) _____ is/are objected to.

Claims 1-23 are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

A restriction is imposed, as set forth below. First, however, the following abbreviations are used hereinbelow:

G1: This subgenus encompasses the compounds disclosed in applications 08/904415, 08/903585, 08/904423, 08/920353, 08/904417, 08/920394, 08/904416.

G2: This subgenus encompasses the compounds of claim 7 wherein R_1 and R_2 form a ring.

G3: This subgenus encompasses the compounds of claim 7 wherein R_1 and R_2 do not form a ring.

[None of the applications referenced in subgenus G1 has been considered. The assumption is that there is no overlap between the compounds of G1, and the compounds of G2 or G3. If this assumption is incorrect, applicants are urged to point this out, with reference to specific pages and line numbers].

*

Restriction to one of the following inventions is required under 35 U.S.C. §121:

1. Claims 1-6, 9, 10 drawn to compounds which include G1, but exclude G2 and G3.
2. Claims 1-7, 9, 10 drawn to compounds which include G2, but exclude G1 and G3.
3. Claims 1-10, drawn to compounds which include G3, but exclude G1 and G2.
4. Claims 11-15, drawn to a method for screening compounds which include G1, but exclude G2 and G3.

5. Claims 11-16, drawn to a method for screening compounds which include G2, but exclude G1 and G3.
6. Claims 11-17, drawn to a method for screening compounds which include G3, but exclude G1 and G2.
7. Claims 18-21, drawn to a method of treating an inflammatory condition by administering a compound which includes G1, but which excludes G2 and G3.
8. Claims 18-22, drawn to a method of treating an inflammatory condition by administering a compound which includes G2, but which excludes G1 and G3.
9. Claims 18-23, drawn to a method of treating an inflammatory condition by administering a compound which includes G3, but which excludes G1 and G2.

The claimed inventions are distinct.

Group 1 has been created in an effort to gain insight into applicants possible intent to claim compounds that are disclosed in other applications. Presumably, Groups 1, 4, and 7 are “null” groups.

Inventions {1-3} and 7-9} are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP 806.05(h)). Nevertheless, in the event that one of Groups 1-3 is and claims

therein found allowable, the method-of-use claims will be rejoined for further examination
[*In re Ochiai* (37 USPQ2d 1127)].

Each of Groups 1, 2 and 3 is drawn to a distinct genus of compounds. The structures and properties will differ, and separate searches will be required.

Applicant is advised that for the response to this requirement to be complete, an election of the invention to be examined must be indicated, even if the requirement is traversed (37 C.F.R. 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

• • •

In addition to the foregoing, applicants are required under 35 U.S.C. §121 to elect a disclosed specie for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. A "specie" is a specific compound, with all substituent variables accounted for.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a generic claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentable distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103 of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton. Phone: (703) 308-3213.

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



DAVID LUKTON
PATENT EXAMINER
GROUP 1600